

### **REMARKS**

Claims 25 through 37 remain pending in the present application. Claims 25 and 33 have been amended. Basis for the amendments can be found throughout the specification, drawings and claims as originally filed.

The undersigned attorney would like to thank Examiner Lieu for the courtesies extended to him during a personal interview on September 18, 2001. During the interview, an agreement was not reached. At the interview, above claim 25 was discussed. It was pointed out that there was no motivation or suggestion cited by the Examiner to combine the teachings of the two references.

### **REJECTION UNDER 35 U.S.C. § 112 (second paragraph)**

The Examiner has rejected claims 33 through 37 under 35 U.S.C. §112, second paragraph, alleging them to be indefinite for failing to particularly point out and distinctly claim subject matter which Applicants regards as the invention. Applicant has amended claim 33 to depend from claim 26. Applicant believes that this overcomes the Examiner's rejection. Applicant believes that this typographical error, which was corrected, is unrelated to patentability.

### **REJECTION UNDER 35 U.S.C. § 103**

The Examiner has rejected claims 25 through 31 under 35 U.S.C. §103, alleging them to be unpatentable over Bein et al in view of Jansky. The Examiner alleges that these two references would render Applicant's invention obvious to those skilled in the art.

Claim 25 defines a power tool which includes a leveling mechanism with a light emitting device coupled with the power tool housing, as well as the power source. The light emitting device illuminates to indicate to a user that the power tool is in a horizontal or vertical position.

The Bein reference cited by the Examiner discloses a level indicating device in a staff level. In the background of the invention, Bein discloses that the level may be placed at a site that is not accessible to a person and thus the observer of a level must remain at a location remote from the level's location. Further Bein points out that lighting conditions at the work place are not always ideal for reading a conventional gas type level. Bein indicates that the level may emit an audible or visual signal to enable a workman to make adjustments without requiring the presence of a second workman. Column 1, lines 12 through 22.

Bein in the summary of his invention, indicates that it is a principle object of the invention to provide a device capable of detecting a truly horizontal or truly vertical condition and indicating same to a remote interested party, consecutively and without repositioning the device or resetting the device. Column 1, lines 45 through 49. Accordingly, the object of the invention is to enable a remote interested party to know when level has been achieved. Thus, the Bein reference as indicated in claim 1, relates to a staff level. This is indicated by the housing having at least one planar surface. Further, the level is a self contained unit within the elongated housing.

The Examiner then combines Jansky to allege that it would be combined with Bein to render Applicant's invention obvious. Jansky discloses a bubble level that is added to or positioned on the outside of the housing. The level has an elbow shape

having bubble levels in both ends. The Examiner alleges that this combination would render Applicant's invention obvious to those skilled in the art.

The Court of Appeals for the Federal Circuit in In Re Fitch 23 U.S.P.Q. 2d 1780 (C.A.F.C. 1992) stated "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absence some teaching or suggestion supporting the combination. Under §103, teaching of references can be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification" of the prior art. The mere fact that the prior art may be modified in the matter suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification".

Here, the Examiner has failed to provide any motivation or the desirability to modify the Bein and Jansky references. The Bein reference clearly shows a standard staff level having an audible or visual sensor which activates at a level position to notify a remote person of the levelness. There is no suggestion or motivation to combine this staff level with the Jansky reference.

Here, the Examiner is relying upon hindsight to arrive at the determination of obviousness. "It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". Id. at 1784.

Accordingly, the Examiner cannot use Applicant's invention as a template. Applicant believes that the Examiner is utilizing the invention as template and picking and choosing pieces of the cited art to combine with Applicant's invention to arrive at Applicant's invention. Clearly this is not the intent of §103.

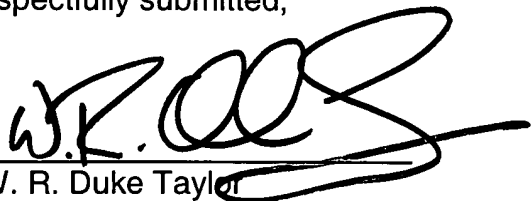
Thus, Applicant believes claim 25, as well as its dependent claims, to be patentably distinct over the art cited by the Examiner.

In light of the above amendments and remarks, Applicant submits that all pending claims are in condition for allowance. Accordingly, Applicant respectfully requests the Examiner to pass the case to issue at her earliest possible convenience. Should the Examiner have any questions regarding the present application, she should not hesitate to contact the undersigned at (248) 641-1600.

Respectfully submitted,

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## **ATTACHMENT FOR CLAIM AMENDMENTS**

The following is a marked up version of each amended claim in which underlines indicates insertions and brackets indicate deletions.

25. (Amended) A power tool comprising:

a housing;

a motor within said housing;

an output coupled with said motor;

an activation member for energizing said motor for rotating said output;

a power source electrically coupled with said motor and said activation member; and

a leveling mechanism comprising a light emitting device coupled with said power tool housing and said power source, said light emitting device illuminating to indicate to a user that the power tool is in a horizontal or vertical position.

33. (Amended) The power tool according to Claim [25] 26, said cavity defined by a pair of opposing conductive conical members acting as said electrical contacts.

Serial No. 09/636,272  
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**POWER TOOL LEVEL INDICATOR**

***Amended Claim 25 for Interview***

25. (Amended) A power tool comprising:
- a housing;
  - a motor within said housing;
  - an output coupled with said motor;
  - an activation member for energizing said motor for rotating said output;
  - a power source electrically coupled with said motor and said activation member; and
  - a leveling mechanism comprising a light emitting device coupled with said power tool housing and said power source, said light emitting device illuminating to indicate to a user that the power tool is in a horizontal or vertical position.